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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK H. FALAHEE

Appeal 2010-001779
Application 10/689,124
Technology Center 3700

Before: FRED A. SILVERBERG, CHARLES N. GREENHUT, and
MICHAEL C. ASTORINO, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-14 and 16. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM-IN-PART.

The claims are directed to a radiopaque marking pen. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A marker particularly valuable to performing invasive surgical procedures, comprising:
a housing in the form of a marking pen; and
a reservoir in the housing that is filled with a substance which, when dispensed through the marking pen, is radiopaque.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

DeSena	US 6,198,807 B1	Mar. 6, 2001
Palasis	US 6,689,103 B1	Feb. 10, 2004

REJECTIONS

Claims 1-8 and 10-13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Palasis. Ans. 4.

Claims 9, 14, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Palasis and DeSena. Ans. 4-5.

OPINION

The rejection of claims 1-8 and 10-13 is affirmed.

Appellant argues claims 1-8 and 10-12 as a group. App. Br. 3. We select claim 1 as the representative claim, and claims 2-8 and 10-12 will stand or fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We agree with, and adopt as our own the Examiner's findings regarding Palasis. We agree that Palasis anticipates claim 1. The Examiner interprets Palasis' sheath 22 as the claimed "housing in the form of a marking pen" and Palasis' lumen 26 as the claimed "reservoir." Ans. 4; Palasis, col. 4, ll. 36-43, fig. 1.

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Appellant contends they have "not departed from the ordinary and customary meaning of marking pen" and that a "marking pen" means "a pen-shaped implement used to mark things." App. Br. 4. Palasis' describes that sheath 22, via injection catheter 40, having microneedles 60, can deliver a radiopaque material to mark an area. Col. 5, ll. 16-47, col. 8, l. 64 – col. 9, l. 4. There is no evidence of record to establish that a "marking pen" must be confined to any particular shape or "form." Appellant does not point to any particular feature of Palasis' sheath which would preclude it from being considered "in the form of a marking pen." Since Palasis' device is capable of marking an area with a radiopaque fluid, we conclude that Palasis' sheath 22 is "in the form of a marking pen," as called for in independent claim 1.

Appellant also argues that Palasis does not include “a reservoir in the housing.” App. Br. 5. Appellant contends that the presence of fluid source 52 in Palasis precludes the Examiner’s interpretation of lumen 26 as the claimed “reservoir in the housing.” Again consulting a dictionary for guidance, we find the most appropriate definition of reservoir to be “a receptacle or chamber for storing a fluid.”¹ While fluid may initially be stored in the source 52 in Palasis, it travels from the source 52 into lumen 46 of tubular member 44 which is contained within sheath lumen 26. Palasis, col. 5, 16-25. If only for a short time before delivery to a patient, lumen 26 is a chamber that may store a radiopaque material with which it is filled before delivery to a patient. Thus the Examiner correctly determined that Palasis’ lumen 26 falls within the broadest reasonable interpretation of the term “reservoir.”

We note that Appellant’s allegation that Palasis is non-analogous art is not germane to the issue of whether Palasis anticipates claim 1. *State Contracting & Eng’g Corp. v. Condotte Am., Inc.*, 346 F.3d 1057, 1068 (Fed. Cir. 2003) (citation omitted).

Turning to claim 13², Appellant contends that “Palasis simply discusses how radiopaque contrast solution may be dispensed from distal end 28 of sheath 22 to enhance fluoroscopic visualization. This has nothing to do with indicating an operative site using a marking pen or comparing the indication to one or more internal structures.” App. Br. 6. Palasis states “[t]he fluid injected into the heart tissue may also include a radiopaque material. Injecting a radiopaque material into the wound effectively marks

¹ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (2007) available at <http://www.credoreference.com/entry/hmdictenglang/reservoir>.

² We interpret “Figure 1” to read “claim 1,” wherein the matter should be corrected in any further prosecution. App. Br. 6.

the locations which have been treated. This will aid the physician in procedures which are being performed percutaneously using fluoroscopic equipment.”³ Col. 11, ll. 18-24. Since the wounds referred to in Palasis are purposefully created during a percutaneous myocardial revascularization (PMR) procedure, the location of the wounds is reasonably interpreted as “an operative site.” Injecting a radiopaque material into a wound then constitutes “indicating an operative site.” Palasis’ statement that “[t]his will aid the physician in procedures which are being performed percutaneously using fluoroscopic equipment” (Palasis, col. 11, ll. 21-23) implies that a physician can both visualize and compare the indications and internal structure of the heart. We are thus unpersuaded by Appellant’s arguments with respect to claim 13.

The rejection of claims 9, 14, and 16 is reversed.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. The key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re*

³ “Fluoroscopic” implies the use of x-rays. *See definition of fluoroscope*, ACADEMIC PRESS DICTIONARY OF SCIENCE AND TECHNOLOGY (1992) available at <http://www.credoreference.com/entry/apdst/fluoroscope>.

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Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418.

Appellant's argument concerning "powder" as recited in claim 9 is that it has nothing to do with minimally invasive techniques. App. Br. 7. We take this as an argument that the Examiner failed to articulate a reason with a rational underpinning to support the conclusion of obviousness. We find nothing in DeSena and no explanation offered by the Examiner regarding why a powder is "minimally invasive" and why Palasis would benefit from a substance "easily removed from the skin or a surgical film" since that is not where Palasis' fluid is applied. *See* Ans. 5, 6-7. Thus, we cannot sustain the Examiner's rejection of claim 9.

Regarding claim 14, Appellant states that "Palasis is clearly directed to invasive procedures unrelated to marking skin, films, erasure, and so forth." App. Br. 7. We note that claim 1 is also directed to performing "invasive" surgical procedures. However, we agree that Palasis is unrelated to marking a surgical film as required by claim 14. We do not see how the teachings of DeSena related to a pressure sensitive surgical film could be combined with those of Palasis, which are related to a device used to deliver fluid to a target site within the body, without departing significantly from the intended purpose of Palasis' device. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, it is unlikely to have been obvious. *See, e.g., In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Thus, we cannot sustain the rejection of claim 14.

The Examiner concludes the subject matter of claim 16⁴ would have been obvious to one having ordinary skill in the art without providing any evidentiary support or articulating a reason with a rational underpinning. Ans. 7, *see also* Reply Br. 2. Since Palasis' device is used inside the body and the fluid is absorbed by the tissue, we do not see how it could be erased. Thus the Examiner's rejection of claim 16 must also be reversed.

DECISION

For the above reasons, the Examiner's rejection of claims 1-8 and 10-13 is affirmed. The Examiner's rejection of claims 9, 14, and 16 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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⁴ Despite failing to mention the claim by number in the grounds of rejection (Final Rej. 4), it is apparent that the Examiner meant to include claim 16 in this ground of rejection because the Examiner discussed the limitations present in claim 16 in the body of the rejection (*id.*).